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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/325,963	06/04/1999	BONNIE WEISKOPF ALBRECHT	54664USA4A	3500
32682	7590	06/02/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			CHANG, VICTOR S	
PO BOX 33427			ART UNIT	
ST. PAUL, MN 55133-3427			PAPER NUMBER	

1771

DATE MAILED 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/325,963

Applicant(s)

ALBRECHT ET AL.

Examiner

Victor S Chang

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- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 18-24, 29-33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16, 29-33 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 4/22/04. Applicants' amendments to claims 13, 14, 29 and 35 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Response to Amendment***

4. Claims 13-15, 31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindquist et al. (US 3665918), substantially for the reasons set forth in section 4 of Paper No. 1006, together with the following additional observations.

It is noted that independent claim 13 has been amended to recite, *inter alia*, "the layer comprising an elastomeric polymer" and "the porosity of which may be increased during use by stretching and which article's porosity is either reversibly or irreversibly changed upon release from stretching by controlling the amount of stretching of the article."

Referring to the newly amended properties, Applicant's arguments "Lindquist does not teach or describe having such properties" (Remarks, page 9, first full paragraph) and "there is nothing in Lindquist to teach or suggest that the reversibility of the increase in porosity of the Lindquist could be controlled by controlling the amount of

stretching" (Remarks, page 9, bottom paragraph) have been carefully considered, but is not persuasive. It is noted that Lindquist expressly teaches that the polyurethane foam web has a splitting resistance of at least an extent of elasticity of at least about 110 percent (Abstract). As such, Lindquist's foam clearly anticipates the foam being an elastomeric polymer. Regarding the product-by-process recitation that the porosity can be either reversibly or irreversibly changed by controlled amount of stretching, the Examiner notes that Applicant must show that the resultant article is patentably distinct from those taught by the reference, because the method of forming the article is not germane to the issue of patentability of the article itself. It should be noted that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Further, the burden of proof for this showing is on Applicant after the Examiner presents an otherwise *prima facie* rejection. See MPEP § 2113.

5. Claims 13-16 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walther (US 5905097), substantially for the reasons set forth in section 5 of Paper No. 1006, together with the following additional observations.

With respect to Applicants' response arguing that "the amended version of claim 13 further recites that the reversibility of the increase can be controlled by controlling the amount of stretching. There is nothing in Walther to teach or suggest a foam having such a property." (Remarks, page 11, top paragraph), the Examiner repeats that the product-by-process recitation that the porosity can be either reversibly or irreversibly

changed by controlled amount of stretching, the Examiner notes that Applicant must show that the resultant article is patentably distinct from those taught by the reference, as set forth above.

6. Claims 29, 30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindquist (US 3665918) in view of Pufahl (US 4169184), substantially for the reasons set forth in section 6 of Paper No. 1006, together with the following additional observations.

Similar to newly amended independent claim 13, it is noted that independent claim 29 has been amended to recite, *inter alia*, "the porosity of which may be increased during use by stretching and which article's porosity is either reversibly or irreversibly changed upon release from stretching by controlling the amount of stretching of the article."

With respect to applicant's response arguing that "Lindquist does not teach or suggest increasing the porosity of the foams by stretching nor does Lindquist describe a foam in which the reversibility of the increase in porosity can be controlled by controlling the amount of stretching." (Remarks, page 11, bottom paragraph), the Examiner again repeats that the product-by-process recitation that the porosity can be either reversibly or irreversibly changed by controlled amount of stretching, the Examiner notes that Applicant must show that the resultant article is patentably distinct from those taught by the reference, as set forth above.

Finally, regarding Applicant's argument that "Since Pufahl does not disclose the claim elements that are lacking from Lindquist, these references even in combination do

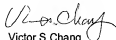
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not render the claimed invention obvious." (Remarks, page 11, bottom paragraph), the Examiner notes that Applicant clearly argues the cited references individually. In response to Applicant's arguments, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

5/27/2004